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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,713	02/11/2004	Patrick M. Cox	41698.1113	2804

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EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/776,713

Applicant(s)

COX ET AL.

Examiner

Allan Hoosain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/11/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-56 are rejected under the judicially created doctrine of double patenting over claims 1-62 of U. S. 6,456,789 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

US 6,456,789, recites limitations which are substantially the same and broader in scope as recited in the claims of the instant Application. For example, US 6,456,789, Claim 1, recites “automatically connecting the customer to a directory assistance provider, and offering a selected service to the customer” and the instant application, Claim 1, recites “connecting the customer to a directory assistance operator”.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Allowable Subject Matter***

2. Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3,5-7,8-12,30-31,33-46,48-56 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Dowden et al.** (US 5,163,083).

As to Claims 1,30,33-34,36-46,48-50,51-56, with respect to Figures 1-8, **Dowden** teaches a method of providing directory assistance services to a customer caller, comprising the steps:

- receiving a customer call on a first inbound channel (Figure 2, label 200);
- eliciting a directory assistance request from the customer (Figure 2, label 204);
- searching a database containing telephone numbers for search results including a destination telephone number that satisfies the directory assistance request (Figure 4);
- allocating a first outbound channel for attempting to establish a connection to a destination telephone associated with the destination telephone number (Figure 7, label 706);
- applying a call analyzer to the first outbound channel (Figure 7, label 708);
- monitoring the first outbound channel with the call analyzer for a configurable period of time to detect connection status condition (Figure 7, label 727);
- detecting a connection status condition (Figure 7, label 727);
- determining if the connection status condition indicates a network communication problem (Figure 7, label 727);
- if the detected connection status condition indicates a network communication problem:
  - without further action by the customer, connecting the customer to a directory assistance operator (Figure 7, label 728); and

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providing the directory assistance operator with search results from the directory assistance request (Figure 7, label 728).

As to Claims 2,31, **Dowden** teaches the method of claim 1, further comprising the step of applying a DTMF detector to the first inbound channel to detect customer input (Figure 2).

As to Claim 3, **Dowden** teaches the method of claim 2, in which the applying a DTMF detector step comprises the step of applying a DTMF detector to the first inbound channel, for the period of time from application of the DTMF detector until the customer disconnects, to detect customer input (Figure 4 and Col. 13, lines 26-35).

As to Claim 5, **Dowden** teaches the method of claim 1, further comprising the steps:

receiving call origination location data on the first inbound channel (Col. 8, lines 53-65);

and

verifying the authority of the customer to attempt to establish a connection to the destination telephone (Col. 8, lines 53-65).

As to Claim 6, **Dowden** teaches the method of claim 1, in which the applying a call analyzer step comprises the step of dedicating a call analyzer exclusively to the first outbound channel (Col. 13, lines 26-35).

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As to Claim 7, **Dowden** teaches the method of claim 1, further comprising the step of applying the call analyzer to a second outbound channel (Figure 7).

As to Claims 8,35, **Dowden** teaches the method of claim 1, in which the connection status condition is one of the set of reorder, PBX intercept, SIT intercept, vacant code, reorder-SIT, no circuit LEC, reorder-carrier, no circuit-carrier, dial tone, continuous on tone, and silence (Figure 8, label 809).

As to Claim 9, **Dowden** teaches the method of claim 1, further comprising the step of terminating the attempt to establish a connection to the destination telephone before connecting the customer to a directory assistance operator (Figure 7, labels 742,732).

As to Claim 10, **Dowden** teaches the method of claim 1, further comprising the step of informing the customer of the network communication problem before connecting the customer to a directory assistance operator (Figure 7, line 728).

As to Claim 11, **Dowden** teaches the method of claim 1, in which the connecting the customer step comprises:

placing the customer call into a call distribution system (Figure 10); and

connecting the customer call to a directory assistance operator specified by the call distribution system (Figure 10).

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As to Claim 12, **Dowden** teaches the method of claim 11, in which the placing the customer call step comprises the step of placing the customer call into a call distribution system with a first assigned priority (Figure 10, label 1004).

5. Claims 13-15,17-23,25-29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Dowden et al.** (US 5,181,237).

As to Claims 13,21, with respect to Figures 3-6, **Dowden** teaches a method of providing directory assistance services to a customer caller, comprising the steps:

- receiving a customer call on a first inbound channel (Figure 3, label 1540);
- eliciting a directory assistance request from the customer (Figure 3, label 1554);
- searching a database containing telephone numbers for search results including a destination telephone number that satisfies the directory assistance request (Figure 3, label 1508);
- allocating a first outbound channel for attempting to establish a connection to a destination telephone associated with the destination telephone number (Figure 3, label 1508);
- applying a call analyzer to the first outbound channel (Figure 3, label 1510);
- monitoring the first outbound channel with the call analyzer for a configurable period of time to detect connection status condition (Figure 3, 1510);
- detecting a connection status condition (Figure 3, label 1510);
- determining if the connection status condition is a ring-no-answer condition (Figure 3, label 1510);



if the detected connection status condition is a ring-no-answer condition:

transferring the customer to a voice server while continuing the attempt to establish a connection to the destination telephone over the first outbound channel and continuing to monitor the first outbound channel with the call analyzer (Figure 3, label 1516, 1514);

providing the voice server with search results from the directory assistance request (Figure 4, 1528); and

presenting the customer with a menu of directory assistance options (Figure 4, label 1528).

As to Claims 14,22, **Dowden** teaches the method of claim 13, further comprising the step of applying a DTMF detector to the first inbound channel to detect customer input (Figure 4, label 1524).

As to Claims 15,23, **Dowden** teaches the method of claim 14, in which the applying a DTMF detector step comprises the step of applying a DTMF detector to the first inbound channel, for the period of time from application of the DTMF detector until the customer disconnects, to detect customer input (Figure 3, label 1512).

As to Claims 17,25, **Dowden** teaches the method of claim 13, further comprising the steps:

receiving call origination location data on the first inbound channel; and

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verifying the authority of the customer to attempt to establish a connection to the destination telephone (Col. 7, lines 1-13).

As to Claims 18,26, **Dowden** teaches the method of claim in which the applying a call analyzer step comprises the step of dedicating a call analyzer exclusively to the first outbound channel (Figure 1, label 1510).

As to Claims 19,27, **Dowden** teaches the method of claim 13, further comprising the step of applying the call analyzer to a second outbound channel (Figure 5, label 1626).

As to Claims 20,28-29, **Dowden** teaches the method of claim 13, in which the menu of directory assistance options includes the set of options comprised of one or more of the following:

- conveying the destination telephone number to the customer;
- transmitting the destination telephone number to the customer's alphanumeric communication device;
- transferring the customer to a directory assistance operator;
- continuing to monitor the first outbound channel with the call analyzer; and
- recording a message to be delivered to a destination party associated with the destination telephone number (Figure 5).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 4,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dowden '083** in view of **Bannister et al.** (US 5,668,862).

As to Claims 4,32, **Dowden** teaches the method of claim 1, in which the customer call is originated from a terminal;

**Dowden** does not teach the following limitation:

“a wireless terminal”

However, it is obvious that **Dowden** suggests the limitation. This is because **Dowden** teaches terminals are connected via interconnected networks (Col. 7, lines 9-30). **Bannister**

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teaches interconnected networks with wireless terminals (Figure 1A). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add wireless telephone capability to **Dowden's** invention for interconnecting wireless terminals as taught by **Bannister's** invention in order to provide directory services from wireless and wireline terminals.

9. Claims 16,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dowden '237** in view of **Bannister et al.** (US 5,668,862).

As to Claims 16,24, **Dowden** teaches the method of claim 1, in which the customer call is originated from a terminal;

**Dowden** does not teach the following limitation:

“a wireless terminal”

However, it is obvious that **Dowden** suggests the limitation. This is because **Dowden** teaches terminals are connected via interconnected networks (Figure 1, label 30). **Bannister** teaches interconnected networks with wireless terminals (Figure 1A). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add wireless telephone capability to **Dowden's** invention for interconnecting wireless terminals as taught by **Bannister's** invention in order to provide directory services from wireless and wireline terminals.

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*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Daudelin** (US 4,922,519) teaches operator assistance with connection of callers to operators.

**Daudelin** (US 4,959,855) teaches automatic connection of callers to directory numbers without callers being disconnected.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

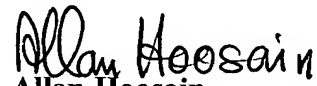
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Carlyle, Alexandria, VA 22313  
(Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (571) 272-7543. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (571) 272-7547.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

  
**Allan Hoosain**  
**Primary Examiner**  
5/16/05